

**REMARKS**

Claims 1-58 are pending.

Of these claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are presented for present consideration. The withdrawn claims are cancelled.

Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are rejected under 35 USC § 101, and then again under 35 USC 103(a).

Claim 1 is currently amended.

**Rejections under 35 USC § 101,**

Claims 1, 5, 6, 10, 14, 19, 22, 24, and 35 are rejected under 35 USC § 101.

Claim 1 has been amended to recite a processor, as per MPEP 2106 and therefore hardware configured with a data structure is claimed, which constitutes allowable subject matter.

“Claims that define a computer-related invention as a specific machine or specific article of manufacture must define the physical structure of the machine or manufacture in terms of its hardware or hardware and "specific software."

In addition an output is claimed, that gives an indication of whether the material being searched for has been found by the search functionality. Such a concrete result renders the claim patentable irrespective of the association with the node in the previous paragraph. Examiner argues that any abstract algorithm can indicate and can have searches. Examiner is respectfully believed to be wrong. An algorithm can only have a concrete result if it is implemented. Implementation can either be by a human (non-statutory) or by a machine (statutory – subject matter). The addition of an output into the claim excludes the former possibility – the human – and therefore renders the claim statutory.

In any event the point is moot since applicant has voluntarily agreed to add a processor.

**Priority Date**

Examiner states that the claims are not fairly based on the provisional application from which priority is claimed.

Examiner further states that he read the provisional and could not find *any support* for the claims.

The following is claim 1 with annotations from US Provisional Application No. 60/259,228 from which priority is presently claimed.

1. A system for external monitoring of networked digital file sharing (see page 5 lines 3 and 4, “the system connects to to the target file sharing networks” – if it connects it must be external) to track predetermined data content, the system comprising:

a processor configured to provide:

at least one surveillance element (see page 5 line 5 “surveillance elements of the first kind”) for distribution over said network (“appear to be regular agents or clients of the file sharing network” Page 5 lines 7 – 8 – agents are software entities that distribute themselves and the passage makes clear that the place of distribution is at the file sharing network, ), said surveillance elements comprising:

search functionality for searching of said networked digital file sharing (“the surveillance elements use a polymorphic search” Page 5 line 9) ;

identification functionality associated with said search functionality for identification of said predetermined data content at a given file sharing system (“The surveillance elements use polymorphic indexed search, that is based on the content name and/or descriptor...” page 5 line 23 ff), therewith to determine whether said given file sharing system is distributing said predetermined data content (“The search for a specific content” page 5 line 11), and

an output, associated with said identification functionality, to produce an output indicative of said determining (page 6 line 6 “the elements can report...”).

As per the above, every element of claim 1 is to be found in the priority document. Thus claim 1 is fully entitled to its priority date and Brown is not citable against claim 1.

**Rejections under 35 USC 103.**

The present application was filed on 3<sup>rd</sup> July 2001 claiming the priority of US Provisional Patent Application No. 60/259,228 filed 3<sup>rd</sup> January 2001. The effective filing date for all subject matter present in the provisional application is therefore 3<sup>rd</sup> January 2001.

All the claims are fairly based on the provisional application, as outlined above under the previous heading. By "fairly based" is meant both that they are taught in the provisional application, as outlined above, and that they are supported by the provisional application in the sense that a skilled person would know how to provide one embodiment within the scope of the claim, so that the provisional application is enabling..

The citation to Browne, having an earliest date of March 27, 2001, is therefore not proper prior art to the present claims.

Irrespective of the priority date issue, Browne fails to teach the searching of *predetermined* material as defined in claim 1 and further fails to teach *distribution* of *surveillance elements* on the file sharing network.

1) Browne does not teach searching for *predetermined* material, contrary to the requirement of claim 1. Rather Browne implies watching the individual users and their personal *downloading activities overall*, "who is downloading what and when". That is to say the implication is that the software picks on a particular user and makes *a complete list of his downloads*, whereas the claim requires that *predetermined material* is searched for, that is to say material predefined (typically by the rights owner) is tracked.

2) Browne fails to teach elements distributed over the file sharing network. Rather Browne merely alleges that the record companies know what the user is downloading, but singularly fails to explain how the information is obtained. He certainly fails to disclose "elements distributed nodewise on a network".

Claim 1 is thus new and inventive because Browne is not citable.

Browne in any event fails to teach surveillance elements distributed over the file sharing network.

Browne in any event fails to teach searching and identification of *predetermined* items.

Thus even if Browne were citable for whatever reason it fails to teach or suggest the features of claim 1.

The dependent claims are allowable as being dependent on an allowable main claim.

#### Conclusion

In conclusion, claim 1 is statutory as defined in MPEP 2106.

claim 1 is entitled to its priority date and so Browne is not citable.

In the alternative, should the Examiner manage to find an earlier effective date for Browne so that it is regarded as citable then Browne fails to teach the indicated elements of the claim.

All the issues raised by the Examiner have been dealt with.

As no substantive amendment is made to the main claim no RCE is believed to be necessary. No further search or consideration is rendered necessary by the present amendments, which merely remove the term “node” and add the term “processor”. Furthermore the present response shows that the claim is entitled to its priority and therefore renders Browne uncitable, therefore placing the claims in order for allowance. In the alternative Browne is shown not to teach or suggest claim 1, again rendering the claims in order for allowance.

It is pointed out that this response contains *two alternative* reasons as to why claim 1 should be allowable. The first is because it predates Browne and the second is because Browne fails to teach or hint at the claimed features. If *either one* of these is correct then the claim is allowable. Applicant sincerely believes that *both* arguments are correct. In the current Office Action, particularly the response to arguments, the Examiner only relates to the issue of whether the claim is entitled to its priority date and does not relate to the applicant's argument in the alternative, that Browne fails to teach the claimed features. The Examiner merely states that since the claims are the same scope as before the same rejection applies, without taking into account applicant's arguments regarding the content of the rejection.

Prompt notice of allowance is earnestly and respectfully requested.

Respectfully submitted,



Martin Moynihan

Registration No. 40,338

Date: August 26, 2008

**Enclosures:**

- Petition for Extension (one month)